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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,910	07/31/2003	Hiroyuki Yanagisawa	KON-1807	9630

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EXAMINER	
CHEA, THORL	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/631,910	YANAGISAWA, HIROYUKI	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1278101 (EP'101). See pages 70-83, claims 1-27, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of EP'101 because of the similarity of the composition of the claimed material and that of the EP'101. In the absence of

showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishijima et al (US Patent No. 6,699,649). See columns 94-98 claims 1-24, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '649 patent because of the similarity of the composition of the claimed material and that of the '649 patent. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

5. Claims 1-12, 18-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oya et al (US Patent No. 6,376,166). See columns 97-102 claims 1-18, which discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '166 patent because of the similarity of the composition of the claimed material and that of the '166 patent. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made

6. Claims 1-12, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Van Ackere (US Patent No.

6,284,442), or Iwasaki et al (US Patent No. 6,268,118). See '442 patent in columns 24 claim 7; and the '118 patent in column 28-30, claims 1-21. The '442 patent, and '118 patent disclose a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the ''442, and '118 patents because of the similarity of the composition of the material . In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made.

7. Claims 1-13, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka et al (US Patent No. 6,413,712). See column 51-12 claims 1-14 wherein the material contains a phenol compound of formula (II) within the scope of formula of claim 13 of the present invention. The '712 patent discloses a photothermographic material as claimed. The value of (L, u*, v*) in the CIELAB system presented in the claimed is related to the properties of the material after the image forming process, and is considered as inherent to the material of the '712 patent because of the similarity of the composition of the material . In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art at the time the invention was made

8. Claim 13-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Oya et al (US Patent No.6,376,166).

The Oya discloses photothermographic material having a reducing agent within the scope of the claimed invention. See compound of formula (I) in the abstract and the definition of V^9 in

column 7, lines 55-60 which an aryl group such as phenyl, p-methylphenyl and naphthyl. See also the hydrazine compound and nucleating agent in columns 55-64. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the reducing agent within the scope of Oya's suggestion, and thereby provide a material as claimed.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,699,649. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the material contains same reducing agent. See the reducing agent in claims 1-2 of the '649 vs. claims 13-15 of the present claimed invention.

Response to Arguments

11. Applicant's arguments filed December 22, 2004 have been fully considered but they are not persuasive of the reason set forth above. In their remark, the applicants'argued that "In each one of these, the Examiner had taken the position that each one of these six references inherently possess the value of L*, u*, v* in the CIELAB system and, thus, the R2 value as of L, recited in

the claims. In order to refute this argument and noting that EP' 101 and Nishijima are the same, five different materials were prepared and tested in order to determine their R^2 value. The test results are reported in the Declaration of Mr. Yanagisawa which is attached hereto. In Mr. Yanagisawa's Declaration, he tests each one of the materials and determines their R^2 values. As can be seen by the data presented in Mr. Yanagisawa's Declaration, none of these materials meet the R^2 values as recited in the claims; namely, none of the references have an R^2 value between 0.998 to 1.000. It is respectfully submitted that, based on the tests presented herein, the 1649 Patent does not claim the same material as the present Invention and it is not an obvious variant thereof. Respectfully, no Terminal Disclaimer needed.

It is the Examiner's position that the applicants'argument is not persuasive for the reason set forth in the rejection above. The composition of the claimed invention such as light-sensitive silver halide grains, an organic silver salts and a reducing agent wholly encompasses the scope of the composition of the photothermographic material of the applied prior art of record. The light-sensitive silver halide grains, light-insensitive organic silver salt and reducing agent are common additive for the photothermographic material. The value of CIELAB presented in the claimed invention is related to the material after imagewise exposure and heat developing. The worker of ordinary skill in the art would have selected the type of imagewise exposure and time of processing to provide an image having a good tone. The value in the CIELAB present in the claimed invention may be outside the scope of claimed in the claimed invention. However, this value cannot use to differentiate the composition of the material of the claimed invention and that of the applied prior art of record since this value vary depending of the processing condition such as light of different wavelength, time and amount of heat used in the process. Since the

composition of the claimed material wholly encompasses the scope of material of the applied prior art of record, the claimed is still found anticipated by the applied prior art such as presented above. The applicants stated that the material is prepared according to the applied prior art of record, but fails to show the what type of test used in the determining the CIELAB or the superior results of the claimed material and that of the applied prior art of record. Therefore, the Declaration as submitted have a little probative value. Moreover, the material having R2 value presented in the specification disclosure has composition different from that claimed in the present claimed invention.

12. The objection to the specification set forth in the previous office action is withdrawn in view of the applicants'argument submitted on December 22, 2004.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea
March 9, 2005

Thorl Chea
Primary Examiner
Art Unit 1752